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10/026,301	12/19/2001	Maurice R. De Billot	17396/09015	8087

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 07/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/026,301

Applicant(s)  
Coultas et al

Examiner  
Alton Pryor

Art Unit  
1616



-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 2, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above, claim(s) 4-12, 21, 22, 47, 49, 56, 58, 73, and 74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 13-20, 23-35, 38-41, 50-54, 59-65, 68, 71, 72, and 75 is/are rejected.
- 7) ☒ Claim(s) 36, 37, 42-46, 48, 55, 57, 66, 67, 69, and 70 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4,6 6) ☐ Other: \_\_\_\_\_

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***Claim Rejections under 35 U.S.C. 103(a)***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3,13-20,23,31,32,38-41,71,72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mauler-Machnik et al (US 6559136; 5/6/03) teaches a fungicidal composition comprising an active diazine compound of formula I plus at least one other active compound selected from prior art compounds 1-82. See column 1 line 22 - column 2 line 59. See column 3 lines 43-47. Within the list of compounds 1-82, compound 54 (captan) and compound 74 (silthiopham) are cited as other ingredients to be added to said composition comprising the active diazine compound. Mauler-Machnik teaches a method wherein the composition is applied to above ground plant propagation material (foliage) and to plant seeds. See column 5 lines 39-49. Mauler-Machnik does not provide an Example composition / method comprising both silthiopham and captan. However, it would have been obvious to one having ordinary skill in the art to combine into a single composition the active ingredient of Formula I with captan and silthiopham and to have applied the composition to said propagation material and seed. One having ordinary skill in the art would have been motivated to make a method that would have been effective at controlling phytopathogenic fungi on plants. With respect to instant amounts of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts of

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ingredients. One having ordinary skill in the art would have been motivated to do this in order to develop the most effect method for controlling plant fungi growth.

3. Claims 1-3,13-20,23-31,33-35,38-41,50-54,59-65,68,71,72,75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simons (EP 067479; 6/7/82) and Mauler-Machnik above. Simons teaches a method of applying a composition comprising captan plus other actives to plant seeds such as sorghum, soybean, rice, peas, potato, and cotton seeds for the control of seed borne pathogens. See abstract, page 1 line 1 - page 2 line 34. Simons does not teach the method comprising silthiopham. However, Mauler-Machnik teaches a method of applying a composition comprising silthiopham and at least one other active to plant seeds. Mauler-Machnik teaches that the other active ingredient can be captan. See column 1 line 22 - column 2 line 59. See column 3 lines 43-47. It would have been obvious to one having ordinary skill in the art to combine the prior art methods to arrive at the instant invention of applying the composition to said seeds. One would have been motivated to do this because both captan and silthiopham are individually taught to control pathogenic fungi on plants. With respect to instant amounts of ingredients; one having ordinary skill in the art would have been expected to determine the optimum amounts of ingredients. One having ordinary skill in the art would have been motivated to do this in order to develop the most effect method for controlling plant fungi growth.

#### ***Double Patenting Rejection***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

Claims 1-3,13-20,23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,8,23 of copending Application No. US20030060371. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications teach a method of applying silthiopham to a plant or its propagation material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Election***

The elected invention comprising captan and silthiopham is not allowable. See art rejections above.

***Claim Objection***

Claims 36,37,42-46,48,55,57,66,67,69,70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach or suggest the instant method comprising the instant seed inoculation and the instant method comprising a transgenic event, and the instant method comprising a product of a QTL-based breeding program.


***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
Alton Pryor  
**ALTON N. PRYOR**  
**PRIMARY EXAMINER**

Primary Examiner, AU 1616

7/2/03